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10/628,411

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John F. Gullo

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

JUNG, ALLEN J

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

02/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/628,411

Applicant(s)

GULLO ET AL.

Examiner

ALLEN J. JUNG

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8,11-28,30,31 and 33-45 is/are pending in the application.
- 4a) Of the above claim(s) 7,8,18,19,28,30,31 and 33-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,11-17,20-27 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the response filed on December 22, 2008.
2. Claims 1, 5, 11, 14-17, 20-22, and 24-26 have been amended.
3. Claim 45 has been added.
4. Claims 1-2, 5-8, 11-28, 30-31, and 33-45 are currently pending, with claims 7-8, 18-19, 28, 30-31, and 33-44 withdrawn from consideration.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 22, 2008 has been entered.

Priority

6. The Examiner had previously objected to the Applicants' claim for the benefit of priority under 35 USC 119 (e). The Examiner now withdraws the objection.

Previous Claim Rejections - 35 USC § 112

7. Claims 1-2 and 5-6 were previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner now withdraws the rejection.

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Response to Arguments

8. Applicant's arguments with respect to claims 1-2, 5-6, 11-17, 20-27, and 45 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-2, 5-6, 20-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines. '); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle

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into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO's "Guidance for Examining Process Claims in view of *In re Bilski*" memorandum dated January 7, 2009, http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf.

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>.

Claims 1-2, 5-6, 20-23 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claims 1-2, 5-6, 20-23 are non-statutory under § 101.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

13. Claims 1-2, 5-6, 11-17, 20-27, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitehouse (US 6,005,945), in view of Sansone et al (US 5,019,991).

Claims 1 and 11:

Whitehouse, as shown, discloses the following limitations:

- a) *estimating a postage amount necessary to send a piece of mail;* (See at least Fig 5A: items 200 and 206, and col13:lines5-10)
- b) *prepaying for the estimated postage amount;* (See at least col13:lines5-10, col13:lines51-55, and col14:lines37-46)
- c) *printing the estimated postage amount, an addressee information, a sender information, and a date on a postage indicia, the postage indicia including the estimated postage amount in a format readable by machine only.* (See at least Fig 5B:item220 and col13:lines22-38, col13:lines55-60)
- d) *affixing to a mailpiece the postage indicia;* (See at least Fig 6:items 105 & 107)
- e) *mailing the mailpiece;* (See at least Fig 8: item312)

With regard to the limitation a, Whitehouse teaches that a postage amount is estimated, because in at least Fig 5A: item 200, it is depicted that the postage calculation is based on a user-input weight. It is also noted that in at least Fig 8 and col22:lines14-20, Whitehouse discloses that such postage amount is validated using "mail piece's weight as determined by the postage scanning station 253." Therefore, Whitehouse's initial generation of postage amount is an estimated value (steps in Fig 5A) that uses user-input parameters.

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With regard to the limitation b, Whitehouse teaches, in at least the lines cited, that the user pays the calculated postage amount via user account.

With regard to the limitation c, Whitehouse discloses, in at least col13:lines22-38, that items such as "date of mailing," "postage," "origin:ZIP+4+2," and "destination:ZIP+4+2" are included in "the data included in each postage indicium generated by the central secure computer. Whitehouse also discloses, in at least the lines cited, that the user "prints the mail piece label with the indicium and digital signature in the message as a two dimensional barcode..." Here, this "two dimensional barcode" teaches the limitation "*postage indicia including the estimated postage amount in a format readable by machine only*," because Whitehouse's indicia is certainly including this two-dimensional barcode, and this two-dimensional barcode is a format readable by machine only.

Whitehouse does not specifically disclose the following limitation. However, Sansone, as shown, does:

- *paying an adjusted postage amount, subsequent to the mailing of the mailpiece, in response to a bill.* (See at least col2:lines25-37)

Sansone, in at least the lines cited, discloses that "where short paid mail occurs, as for example, where weighted mail is being marked with an indicia for a presort discount and/or a bundling discount and it is determined that this discount is not properly available, in conjunction with the evidence of postage payment already coded or read into the system, the system may debit an advance deposit account for adjusting electronically for the short paid mail. The advantage to the user is that no mail is returned for short payment."

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Whitehouse's postage calculation/mailing procedure, with adjusted postage payment scheme taught by Sansone. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

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One of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 11, this claim encompasses substantially the same scope as claim 1. Accordingly, claim 11 is rejected in substantially the same manner as claim 1, as described above.

Claims 2 and 12:

Whitehouse, as shown, discloses the following limitation:

- *prepaying the estimated postage amount comprises prepaying the estimated postage via the Internet.* (See at least col7:lines64-47, and col14:lines37-46)

Whitehouse, in at least col7:lines64-47, discloses that the user's computer is connected via "a communication interface 112 such as a modem, LAN connection, or Internet connection, for handling communications with one of the secure central computers 102" Whitehouse further discloses, in at least col14:lines37-46, that "the present invention completely abandons the concept of a locally maintained postage balance. Instead the official balance for any given user is maintained at the centralized secure computer. The balance may be increased at any time by the user through any number of secure means (e.g., a check taken to a local post office, funds mailed, or credit card transactions via the Web). All of these postage increase transactions are handled by the central secure site where standard payment verification techniques can be applied before the balance is actually updated." Here, Whitehouse clearly teaches that replenishable account exists at a central computer, which user could manage and replenish over the Internet.

As per claim 12, this claim encompasses substantially the same scope as claim 2. Accordingly, claim 12 is rejected in substantially the same manner as claim 2, as described above.

Claims 5 & 45:

Whitehouse, as shown, discloses the following limitation:

- *(claim 5) the format readable by machine only comprises a bar code format* (See at least col13:lines55-60)

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- *(claim 45) wherein the bar code format is a 2 dimensional bar code format* (See at least col13:lines55-60)

Whitehouse discloses, in at least the lines cited, that the user "prints the mail piece label with the indicium and digital signature in the message as a two dimensional barcode..."

Claims 6 & 17:

Whitehouse, as shown, discloses the following limitation:

- *Verifying that the postage indicia has not previously been used on a second mailpiece.*
(See at least col13:lines23-40)

Whitehouse, in at least the lines cited, discloses that "license ID" and "Serial number" are among items included in the indicium, and that "the license ID and serial number together uniquely identify each mail piece." Therefore, in generating and including the license ID and serial number into the postage indicium, Whitehouse's system is verifying the uniqueness of this indicium to this particular mailpiece.

As per claim 17, this claim encompasses substantially the same scope as claim 6. Accordingly, claim 17 is rejected in substantially the same manner as claim 6, as described above.

Claim 13:

Whitehouse, as shown, discloses the following limitation:

- *A printer for printing the postage indicia.* (See at least col13:lines55-60)

Claim 14:

Whitehouse, as shown, discloses the following limitation:

- *A processor for encoding the stealth postage by printing a postage amount, an addressee information, a sender information, and a date.* (See at least col13:lines22-38)

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Whitehouse discloses, in at least col13:lines22-38, that items such as "date of mailing," "postage," "origin:ZIP+4+2," and "destination:ZIP+4+2" are included in "the data included in each postage indicium generated by the central secure computer.

Claims 15 & 16:

Whitehouse, as shown, discloses the following limitation:

- (Claim 15) *The stealth postage is a bar code format* (See at least col13:lines55-60)
- (Claim 16) *wherein the bar code format is a 2-dimensional bar code format* (See at least col13:lines55-60)

Whitehouse discloses, in at least the lines cited, that the user "prints the mail piece label with the indicium and digital signature in the message as a two dimensional barcode..."

Claims 20 and 24:

Whitehouse, as shown, discloses the following limitations:

- a) *estimating an amount of postage necessary for a mailpiece;* (See at least Fig 5A: items 200 and 206, and col13:lines5-10)
- b) *transmitting payment information;* (See at least col13:lines5-10, col13:lines51-55, and col14:lines37-46)
- c) *printing a postage label including a postage amount represented only in an electronically readable format* (See at least col13:lines55-60)

With regard to the limitation a, Whitehouse teaches that a postage amount is estimated, because in at least Fig 5A: item 200, it is depicted that the postage calculation is based on a user-input weight. It is also noted that in at least Fig 8 and col22:lines14-20, Whitehouse discloses that such postage amount is validated using "mail piece's weight as determined by the postage scanning station 253." Therefore, Whitehouse's initial generation of postage amount is an estimated value (steps in Fig 5A) that uses user-input parameters.

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With regard to the limitation b, Whitehouse teaches, in at least the lines cited, that the user pays the calculated postage amount via user account.

With regard to the limitation c, Whitehouse discloses, in at least the lines cited, that the user "prints the mail piece label with the indicium and digital signature in the message as a two dimensional barcode..." Here, this "two dimensional barcode" teaches the limitation "*postage label including a postage amount represented only in an electronically readable format*," because Whitehouse's indicia is certainly including this two-dimensional barcode, and this two-dimensional barcode is a format readable by machine only.

Whitehouse does not specifically disclose the following limitation. However, Sansone, as shown, does:

- *printing a postage label including a verification information used by a mailing system to subsequently adjust the mailing postage amount, wherein the verification information associates a sender's billing information with the mailpiece.* (See at least col5:lines4-10, and col4:lines29-34)

Sansone, in at least col5:lines4-10, discloses that "the descending registers are appropriately debited to reflect the correct postage." Here, the "descending register" is referring to "sender's descending register balances" (col4:lines29-34). Therefore, some time before the actual financial adjustment is made, information with regard to sender's descending register balance (e.g. how to locate it) is received by the system. Sansone does not explicitly specify *when* that information is received. However, it would have been obvious to one of ordinary skill in the art at the time of invention that this receiving step occurs through the mail piece's barcode while it is reading barcode from the mailpiece (step represented by Fig 2: items 1000 and 1002). One would have been motivated to find it obvious, because Sansone clearly states in at least col4:lines51-59 that these data are input as a "step of providing appropriate transactional mail run data," and one skilled in the art would recognize that the sender's descending register is clearly an appropriate transactional mail run data.

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It would have been obvious to one of ordinary skill in the art at the time of invention to combine Whitehouse's postage calculation/mailling procedure, with adjusted postage payment scheme taught by Sansone. The claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. One of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 24, this claim encompasses substantially the same scope as claim 20. Accordingly, claim 24 is rejected in substantially the same manner as claim 20, as described above.

Claims 21 and 25:

Whitehouse, as shown, discloses the following limitation:

- *creating the postage label by producing a bar code containing a date, the postage amount, an addressee information, and a sender information* (See at least Fig 5B:item220 and col13:lines22-38, col13:lines55-60)

Whitehouse discloses, in at least col13:lines22-38, that items such as "date of mailing," "postage," "origin:ZIP+4+2," and "destination:ZIP+4+2" are included in "the data included in each postage indicium generated by the central secure computer. Whitehouse also discloses, in at least the lines cited, that the user "prints the mail piece label with the indicium and digital signature in the message as a two dimensional barcode..."

As per claim 25, this claim encompasses substantially the same scope as claim 21. Accordingly, claim 25 is rejected in substantially the same manner as claim 21, as described above.

Claims 22 and 26:

Whitehouse, as shown, discloses the following limitation:

- *the bar code further comprises a number unique to the postage indicia.* (See at least col13:lines23-40)

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Whitehouse, in at least the lines cited, discloses that "license ID" and "Serial number" are among items included in the indicium, and that "the license ID and serial number together uniquely identify each mail piece."

As per claim 26, this claim encompasses substantially the same scope as claim 22. Accordingly, claim 26 is rejected in substantially the same manner as claim 22, as described above.

Claims 23 and 27:

Whitehouse, as shown, discloses the following limitation:

- *wherein the bar code is a two dimensional bar code* (See at least col13:lines55-60)

Whitehouse discloses, in at least the lines cited, that the user "prints the mail piece label with the indicium and digital signature in the message as a two dimensional barcode..."

As per claim 27, this claim encompasses substantially the same scope as claim 23. Accordingly, claim 27 is rejected in substantially the same manner as claim 23, as described above.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Allen J. Jung whose telephone number is 571.270.3919. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, JOHN W. HAYES can be reached at 571.272.6708.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free).

Any response to this action should be mailed to:

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February 24, 2009

/Allen J Jung/ Examiner, Art Unit 3628

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628